

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1-4 are objected to because of the following informalities:

Throughout claims 1-4, "...one sides..." and "...other sides..." should read "...one side..." and "...other side...", respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert Templeton (US 6152029) in view of David Kloosterman et al (US 7375842 B2).

Regarding claim 1, Templeton discloses an image forming system which is for forming a fixed image on one side of a plurality of recording media and variable images different from each other on the other side of the recording media (Fig. 2 electronic control system. Col. 1 lines 41-46 wherein fixed data is printed on one side of the medium and variable data printed on the other side of the medium) and comprises a printing information output unit (Fig. 2 numeral 200 which, according to Col. 3 lines 36-38, can be housed in a personal computer) which outputs fixed image data representing the fixed image and a plurality of pieces of variable image data each representing a variable image (Col. 3 lines 38-51 wherein the data controller outputs the fixed and variable data to the inkjet printers (A and B) shown in Fig. 2 numerals 30 and 32), and an image forming apparatus which forms images on opposite sides of the recording media on the basis of the fixed image data and the variable image data output from the printing information output unit (Col. 1 lines 41-46 wherein a 6 color offset printing unit and inkjet printers are used as the output devices), and

Templeton fails to disclose or suggest wherein the improvement comprises a storage portion which is provided in the image forming apparatus to store the fixed image data output from the printing information output unit,

a printing information output control means which causes the storage portion to store the fixed image data output from the printing information output unit and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media.

Kloosterman et al, in the same field of endeavor of printing fixed and variable image data wherein the fixed image data is saved for re-use (Col. 2 lines 19-42 wherein “re-used” elements read on “fixed” image data), teaches a storage portion which is provided in the image forming apparatus to store the fixed image data output from the printing information output unit (Col. 2 lines 38-42 wherein the “fixed” data is stored in cache), a printing information output control means (PPML RIP (raster image processor) described in Col. 2 lines 43-45) which causes the storage portion to store the fixed image data output from the printing information output unit and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media (Col. 2 lines 43-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the invention of Templeton wherein a system for forming a fixed image on one side of a plurality of recording media and variable images different from each other on the other side of the recording media is disclosed to utilized the teachings of Kloosterman et al wherein a storage portion which is provided in the image forming apparatus to store the fixed image data and a printing information output control means which causes the storage portion to store the fixed image data because the “ability to re-use “fixed” elements eliminates the need to resend the source code that defines the content element to the printer/RIP multiple times during the same print job” (Col. 2 lines 45-48, Kloosterman et al).

Templeton also fails to explicitly disclose an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one side of a plurality of recording media and to receive a plurality of

pieces of the variable image data output from the printing information output unit to form variable images on the other side of a plurality of the recording media.

However, combining the disclosure of Templeton wherein image data is read out to form fixed images on one side of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the printing information output unit to form variable images on the other side with the teachings of Kloosterman et al wherein a storage portion stores the fixed image data would result in the control means which controls image formation in the disclosure of Kloosterman et al (Raster Image Processor as mentioned before) to read out the fixed image data held in the storage to print fixed data on one side of a print medium and variable data on the other side of the print media. The modification of Templeton to use the storage and control means as disclosed by Kloosterman et al would have constituted the mere arrangement of old elements with each performing the same function it had been known to perform, the combination yielding no more than one would expect from such an arrangement. The Court has held that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Regarding claim 3, Templeton discloses an image forming apparatus which is for an image forming system defined in Claim 1 (see rejection of claim 1) and comprises

a storage portion which stores the fixed image data output from the printing information output unit (see rejection of claim 1 wherein the storage is located within the image forming apparatus), and

an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one side of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the printing information output unit to form variable images on the other side of a plurality of the recording media (see rejection of claim 1).

5. Claim 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton in view of Kloosterman et al as applied to claim 1 above, and further in view of Val Skordin et al (WO 03/036430 A2).

Regarding claim 2, Templeton discloses an image forming system as defined in Claim 1.

Templeton fails to expressly disclose or fairly suggest in which the printing information output unit displays in a list a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image selecting means through which image data representing a fixed image to be formed on said one side of the recording media can be selected out of the plurality of fixed image data.

Skordin et al, in the same field of endeavor of creating forms utilizing fixed and variable data for output (Abstract), teaches in which the printing information output unit (see rejection of claim 1 wherein the information output unit is embodied within a computing environment) displays in a list a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image selecting means (Fig. 3 numeral 66 in which a "document" is selected from a document catalog. Fig. 2 explains how the "documents" are created and stored in advance. Page 7, ¶ [2] lines 3-7 explain the "documents" which are selectable contain static source text and graphics, which read on fixed data. See page 14, ¶ [3] lines 1-3 wherein the document data is combined with the variable data to provide a printed usable form) through which image data representing a fixed image to be formed on said one side of the recording media can be selected out of the plurality of fixed image data (see rejection of claim 1 wherein the fixed image data is printed on one side of the recording media).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the invention as disclosed by Templeton wherein image data is read out to form fixed images on one side of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the printing information output unit to form variable images on the other side to utilize the teachings of Skordin et al wherein the printing information output unit displays in a list, a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image selecting means through which image data representing a fixed image to be formed on said one side of the recording media can be selected out of the plurality of fixed image data because allowing the

fixed image data to be selected from a list of fixed image data creates ease of use for the user and eliminates the need for the user to enter the static or fixed image data on every occasion the document is needed.

Regarding claim 4, Templeton discloses an image forming system which is for forming a fixed image on one side of a plurality of recording media and variable images different from each other on the other side of the recording media and comprises a computer which outputs variable image data representing the variable image of a plurality of pages (see rejection of claim 1), a controller which is provided with a variable image data receipt portion which receives the variable image data output from the computer and an image storage portion which stores a plurality of pieces of fixed image data each representing a fixed image (see rejection of claim 1 wherein the control means receives the variable image data from the computer therefore there must exist a variable image data receipt portion along with the storage portion as rejected in claim 1 above.), and outputs the variable image data received by the variable image data receipt portion and a fixed image data stored in the image storage portion and a printer which forms images on opposite sides of the recording media on the basis of the fixed image data and the variable image data output from the controller (see rejection of claim 1 above), wherein the improvement comprises that

the computer outputs to the controller fixed image designation information for designating one of the plurality of pieces of fixed image data (see rejection of claim 2 wherein the document is selected by the user),

the controller selects one of the plurality of pieces of fixed image data from the image storage portion on the basis of the fixed image designation information output from the computer and outputs the selected fixed image data to the printer and thereafter outputs the variable image data of the plurality of pages to the printer (see rejection of claim 2 wherein the fixed static information of the selected document is combined with the variable data for print output), and

the printer is provided with a storage portion which stores the fixed image data output from the controller, a printing information output control means which causes the storage portion to store the fixed image data and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media (see rejection of claim 1), and

an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one sides of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the controller to form variable images on the other side of a plurality of the recording media (see rejection of claim 1 wherein the printing output control means controls the image forming apparatus to implement the method as rejected in claim 1 above).

Regarding claim 5, Templeton discloses an image forming system as defined in Claim 4 in which the controller and the printer is formed integrally with each other (see rejection and explanation of motivation of claim 1 for modifying the invention of Templeton with the control means provided by Kloosterman et al).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARES WASHINGTON whose telephone number is (571)270-1585. The examiner can normally be reached on Monday thru Friday: 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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